

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Ex parte Douglas M. Macheel and Lee B. Max

Appeal No. 2006-0562
Application No. 09/952,588

ON BRIEF

Before KRASS, RUGGIERO, and DIXON, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 39-52 and 55-57, which are all of the claims pending in this application.

We AFFIRM.

BACKGROUND

The appellants' invention relates to a solid state power amplifying device. A copy of representative claims 39 and 55 under appeal are set forth below.

39. A solid state power amplifying device comprising:

- a die;

- a first input bond pad mounted on the die;

- a first input lead; and

- a first bond wire positioned on the first input lead to control the magnitude of high frequency current delivered to the first input bond pad.

55. A solid state power amplifying device comprising:

- a die;

- a first input bond pad mounted on the die;

- a second input bond pad mounted on the die;

- a first input lead;

- a first bond wire coupled between the first input bond pad and a first edge of the first input lead; and

- a second bond wire coupled between the second input bond pad and a second edge of the first input lead, the first and second bond wires are positioned on the first input lead to control the magnitude of high frequency current delivered to the first and second input bond pads, wherein an equivalent magnitude of current is supplied to the first and second input bond pads.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

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Takubo et al.	4,991,001	Feb. 5, 1991
Notani et al. (Notani)	5,294,897	Mar. 15, 1994
Vercellotti et al. (Vercellotti)	5,774,000	Jun. 30, 1998
Kojima	6,023,080	Feb. 8, 2000
Dickson et al. (Dickson)	6,056,186	May 2, 2000
Nakayama et al. (Nakayama)	6,208,023	Mar. 27, 2001
Seshita et al. (Seshita)	6,366,770	Apr. 2, 2002
		(Filed Mar. 16, 1999)
Kamiya	6,492,667	Dec. 10, 2002
		(Filed April 19, 2000)

Claims 55 and 56 stand rejected under 35 U.S.C. § 102 as being anticipated by Nakayama. Claims 55 and 56 stand rejected under 35 U.S.C. § 102 as being anticipated by Dickson. Claims 39, 40, and 45 stand rejected under 35 U.S.C. § 102 as being anticipated by Seshita. Claim 55 stands rejected under 35 U.S.C. § 102 as being anticipated by Notani. Claims 41, 43, 44, and 46-52 stand rejected under 35 U.S.C. § 103 as being unpatentable over Seshita in view of Takubo. Claims 41, 43, 44, and 46-52 stand rejected under 35 U.S.C. § 103 as being unpatentable over Seshita in view of Kamiya. Claims 39-41 and 43-52 stand rejected under 35 U.S.C. § 103 as being unpatentable over Kojima in view of Nakayama. Claim 42 stands rejected under 35 U.S.C. § 103 as being unpatentable over Kojima in view of Nakayama further in view of Vercellotti. Claim 57 stands rejected under 35 U.S.C. § 103 as being unpatentable over Notani.

Rather than reiterate the conflicting view points advanced by the examiner and appellants regarding the above-noted rejections, we make reference to the answer (mailed Apr. 7, 2005) for the examiner's reasoning in support of the rejections and to the brief (filed Nov. 12, 2004) for appellants' arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we make the determinations which follow.

35 U.S.C. § 102

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). The inquiry as to whether a reference anticipates a claim must focus on what subject matter is encompassed by the claim and what subject matter is described by the reference. As set forth by the court in **Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984), it is only necessary for the claims to "read on" something disclosed in the reference, i.e., all limitations of the claim are found in the

reference, or 'fully met' by it." While all elements of the claimed invention must appear in a single reference, additional references may be used to interpret the anticipating reference and to shed light on its meaning, particularly to those skilled in the art at the relevant time. **See Studiengesellschaft Kohle, M.B.H. v. Dart Indus., Inc.**, 726 F.2d 724, 726-727, 220 USPQ 841, 842-843 (Fed. Cir. 1984).

To support a rejection of a claim under 35 U.S.C. § 102(b), it must be shown that each element of the claim is found, either expressly described or under principles of inherency, in a single prior art reference. **See Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984).

Initially we note that anticipation by a prior art reference does not require either the inventive concept of the claimed subject matter or the recognition of inherent properties that may be possessed by the prior art reference. **See Verdegaal Bros. Inc. v. Union Oil Co.**, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir.), **cert. denied**, 484 U.S. 827 (1987). A prior art reference anticipates the subject of a claim when the reference discloses every feature of the claimed invention, either explicitly or inherently (see **Hazani v. United States Int'l Trade Comm'n**, 126 F.3d 1473, 1477, 44 USPQ2d 1358, 1361 (Fed. Cir. 1997) and **RCA Corp. v. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984)); however, the law of anticipation does not require that the reference teach what the appellants are claiming,

but only that the claims on appeal "read on" something disclosed in the reference (**see Kalman v. Kimberly-Clark Corp.**, 713 F.2d 760, 772, 218 USPQ 781, 789 (Fed. Cir. 1983), **cert. denied**, 465 U.S. 1026 (1984)).

We must point out, however, that anticipation under 35 U.S.C. § 102 is established only when a single prior art reference discloses, either expressly or under the principles of inherency, each and every element of a claimed invention. **See RCA Corp. V. Applied Digital Data Systems, Inc.**, 730 F.2d 1440, 1444, 221 USPQ 385, 388 (Fed. Cir. 1984).

With respect to independent claim 55, the examiner maintains that Nakayama, Dickson and Notani teach all of the limitations as recited in independent claim 55. Appellants argue that these references do not teach the limitation that "the first and second bond wires are positioned on the first input lead to control the magnitude of high frequency current delivered to the first and second input bond pads, wherein an equivalent magnitude of current is supplied to the first and second input bond pads." (Brief at page 7-11 and 14-15.) The examiner maintains at pages 10-15 and 17-19 of the answer that these references teach the claimed "first and second bond wires are positioned on the first input lead to control the magnitude of high frequency current delivered to the first and second input bond pads, wherein an equivalent magnitude of current is supplied to the first and second input bond pads." We agree with the examiner and find that appellants' argument concerning that the references do not

disclose that the magnitude of current is controlled by the positioning of a bond wire on an input lead is not commensurate in scope with the express language recited in independent claim 55.

Here, it appears that appellants are arguing the express location of the placement of the bond wire on the lead is the control. We do not find such a process limitation in the language of independent claim 55. Independent claim 55 recites a structure including “ first bond wire coupled between . . . a first edge of the first input lead; and a second bond wire coupled between . . . a second edge of the first input lead” We find that each of Nakayama, Dickson and Notani teaches the use of bond wires coupled at the edges of a single lead as recited in independent claim 55. Therefore, we do not find the argument persuasive. Furthermore, we find that any placement of the bond wires would have controlled the magnitude of the current since the location would not change. Since we find that the examiner has established a ***prima facie*** case of anticipation which has not been adequately rebutted, we will sustain the rejection of independent claim 55 and dependent claim 56.

With respect to independent claim 39, the examiner relies upon the teachings of Seshita to teach the claimed “a die; a first input bond pad mounted on the die; a first input lead; and a first bond wire positioned on the first input lead to control the magnitude of high frequency current delivered to the first input bond pad.” We agree with the examiner and find that the placement of the bond wire would necessarily

control the magnitude of the current since nothing in the structure would change. Again, appellants assert that Seshita "...does not disclose that the bond wires are positioned on the pins to control the magnitude of high frequency current delivered to the bond pads as recited in claim 39 . . . Thus, the placement of the bond wires in Seshita has nothing to do with controlling a magnitude of high frequency current." (brief, pg. 13). Here again, we find no limitation in independent claim 39 which limits the structure of the amplifying device to distinguish the structure from Seshita. We do not agree with appellants' argument that the process of placement of the bond wire distinguishes the structure from Seshita. Therefore, we do not find the argument persuasive, and we will sustain the rejection of independent claim 39 and dependent claims 40 and 45.

35 U.S.C. § 103

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a ***prima facie*** case of obviousness. **See *In re Rijckaert***, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A ***prima facie*** case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other modification. **See *In re Lintner***, 458 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the

claimed subject matter is ***prima facie*** obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. **See *In re Fine***, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on § 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. **See *In re Warner***, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), **cert. denied**, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellant's disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior art. **See, e.g., *Grain Processing Corp. v. American Maize-Prods. Co.***, 840 F.2d 902, 907, 5 USPQ2d 1788, 1792 (Fed. Cir. 1988).

When determining obviousness, “the [E]xaminer can satisfy the burden of showing obviousness of the combination ‘only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.’” ***In re Lee***, 277 F.3d 1338, 1343, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002), citing ***In re Fritch***,

972 F.2d 1260, 1265, 23 USPQ2d 1780, 1783 (Fed. Cir. 1992). “Broad conclusory statements regarding the teaching of multiple references, standing alone, are not ‘evidence.’” **In re Dembiczak**, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). “Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact.” **Dembiczak**, 175 F.3d at 999-1000, 50 USPQ2d at 1617, citing **McElmurry v. Arkansas Power & Light Co.**, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993).

Further, as pointed out by our reviewing court, we must first determine the scope of the claim. “[T]he name of the game is the claim.” **In re Hiniker Co.**, 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998). Therefore, we look to the limitations recited in independent claims 39, 52, and 55 and their respective dependent claims. Throughout all of appellants’ arguments, appellants maintain that none of the references applied teach the limitation of controlling the current flow by the placement of the bond wire(s) at specific locations. We do not find the argument persuasive since we find no limitation to the process and no specific location recited which is not taught or fairly suggested by the prior art as discussed above.

With respect to claims 41, 43, 44 and 46-52, appellants argue that all of the elements are not taught or suggested and that neither Seshita nor Takubo teaches or fairly suggests controlling the magnitude of high frequency current delivered to an input bond pad. (Brief at pages 16-17.) As discussed above, we disagree and find that

appellants' argument is not commensurate in scope with the language of the claim which sets forth a specific structure which is taught and fairly suggested by the prior art combination. Therefore, we do not find the argument persuasive, and we will sustain the rejection of claims 41, 43, 44 and 46-52.

We reiterate our same conclusions with respect to the combination of Seshita and Kamiya with respect to claims 41, 43, 44 and 46-52.

With respect to claims 39-41 and 43-52, we reiterate our same conclusions with respect to the combination of Kojima and Nakayama. Appellants argue that neither Kojima nor Nakayama teaches or fairly suggests controlling the magnitude of high frequency current delivered to an input bond pad and therefore all of the elements are not taught or suggested. (Brief at pages 20-21.) As discussed above, we disagree and find that appellants' argument is not commensurate in scope with the language of the claim which sets forth a specific structure which is taught and fairly suggested by the prior art combination. Therefore, we do not find the argument persuasive, and we will sustain the rejection of claims 39-41 and 43-52.

With respect to dependent claim 42, appellants argue that none of Kojima, Nakayama or Vercellotti teach or suggest the controlling as argued and that therefore all of the limitations are not found in the prior art. As above, we disagree with appellants, and will sustain the rejection of dependent claim 42.

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With respect to dependent claim 57, appellants argue that Notani does not teach or suggest the controlling as argued and that therefore all of the limitations are not found in the prior art. As above, we disagree with appellants, and will sustain the rejection of dependent claim 57.

CONCLUSION

To summarize, the decision of the examiner to reject claims 39, 40, 45, 55, and 56 under 35 U.S.C. § 102 is AFFIRMED, and the decision of the examiner to reject claims 39-52 and 57 under 35 U.S.C. § 103 is AFFIRMED.

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No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED

ERROL A. KRASS
Administrative Patent Judge

JOSEPH F. RUGGIERO
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

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NORRIS MCLAUGHLIN & MARCUS, P.A.
P O BOX 1018
SOMERVILLE , NJ 08876

**APPEAL NO. 2006-0562
APPLICATION NO. 09/952,588**

APJ DIXON

APJ RUGGIERO

APJ KRASS

DECISION: AFFIRMED

PREPARED: Apr 29, 2006

OB/HD

PALM:

ACTS 2:

DISK (FOIA):

REPORT:

BOOK:

GAU:

44C1:

IFW in E. Cook's Incoming: